

Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF

COMMISSIONER FOR PATENTS
P.O. Box 1450
ALEXANDRIA, VA 22313-1450

Application Number	09/883,500
Filing Date	June 19, 2001
First Named Inventor	EVERHART <i>et al.</i>
Art Unit	2178
Examiner Name	Kyler Stork
Attorney Docket No.	53470.003038

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this appeal.

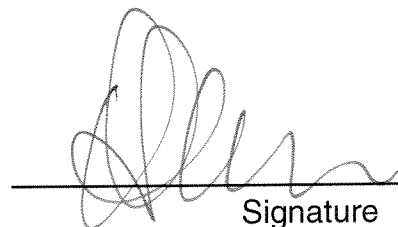
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided

I am the:

☐ Applicant/Inventor



Signature

☐ Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96).

Ozzie Farres

Typed or printed name

CUSTOMER NUMBER 21967

☐ Attorney or Agent of Record _____
(Reg. No.)

(202) 955-1500

Requester's telephone number

☒ Attorney or Agent acting under 37 CFR 1.34.
Registration No. if acting under 37 CFR 1.34 **37,063**

October 20, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms is submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:
	:
L. Douglas Everhart <i>et al.</i>	: Group Art Unit: 2178
	:
Appln. No. : 09/883,500	:
	: Examiner: Kyler Stork
Filed: June 19, 2001	:
	:
For: REPORT SYSTEM AND METHOD :	:
USING PROMPT IN PROMPT :	:
OBJECTS :	:

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicants believe that an appeal will succeed are set forth below.

This application was filed over five years ago on June 19, 2001. On December 17, 2004, an initial office action was issued rejecting the initial claims under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,154,766 to Yost *et al.* (“Yost”). Yost is a patent owned by the same assignee of the above referenced application. Applicants note, under 35 U.S.C. 102 (c) a rejection based on the Yost patent would be improper and thus, the Office attempts to assert that every feature of all 20 claims is disclosed in Applicant’s prior patent. In an effort to streamline prosecution, applicants amended independent claims 1, 6, 11 and 16 to clarify distinctions.

Despite an attempt to distinguish this application from the cited reference, the Office issued a final office action rejecting the claims in view of “Yost” that is certain to be overturned on appeal. Rather than further time being spent addressing this reference, Applicants have elected to pursue the Pre-Appeal Brief Conference Pilot Program.

As set forth in Applicants’ response dated June 7, 2006, the cited reference fails to teach or suggest numerous recitations of the pending claims.

In particular, Applicants respectfully submit that Yost does not disclose “each of the inner and outer prompt objects is an object separate in object oriented programming terms from the report in which it is *contained*” (emphasis added), as recited in claim 1. The Action relies on Figure 3 and its description in column 11, line 1 to column 12, line 35 of Yost to anticipate these claim features. On page 3, the Action equates step 116 from Figures 3 of Yost with the claimed inner prompt object, and, on page 4, the Action equates step 118 from Figure 3 of Yost with the claimed outer prompt object. Thus, the Action appears to be arguing that each of step 116 and 118 of Yost is a prompt object and that each is separate in object oriented programming terms from a report in which it is contained. Yost does not disclose, however, that steps 116 and 118 are contained within the service or within one or more of the reports. Rather, steps 116 and 118 of Yost prompt a user for information before a service is identified by the user, and hence before identifying the included one or more reports that are scheduled to be run. In other words, steps 116 and 118 of Yost prompt a user to identify a service that includes one or more reports, and thus steps 116 and 118 of Yost are not prompts contained within the report. Hence, Yost does not disclose that each of steps 116 and 118 of Figure 3 is a prompt object and that each is an object separate in object oriented programming terms from the service (including the one or

more reports) in which it is *contained*. Thus, the Action has not properly identified that Yost discloses “**each** of the inner and outer prompt objects is an object separate in object oriented programming terms from the report in which it is *contained*” (emphasis added), as recited in claim 1.

The Examiner responded to these arguments in the last Action stating

[t]he applicant is correct in asserting that the user provides information to the prompts prior to the service being initiated. The user selects an answer to a first prompt object (Figure 3, item 116), then subsequently selects an answer to a second prompt object (Figure 3, item 118). Because these are determined prior to scheduling a report, the prompt objects are separate from the report in which it (the data) is contained.

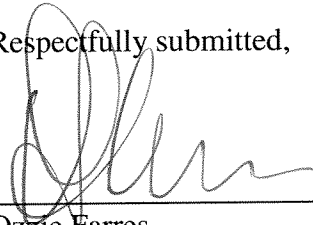
July 20, 2006 Office Action, page 8.

Applicant submits that the Examiner appears to be arguing that Yost’s alleged prompt objects are not contained in the report. Claim 1 requires that “each of the inner and outer prompt objects is an **object separate in object oriented programming terms from the report in which it is contained...**” (emphasis added). Thus claim 1 recites that the prompt objects are contained in the report but are separate in object oriented terms from the report. Applicant submits that the Examiner is incorrectly interpreting the term “it” to refer to data instead of “each of the inner and outer prompt objects.” Thus the Examiner does not even argue that the prompt objects are contained in the report, but separate objects in object-oriented programming terms, as required by the claims.

Clearly, an appeal of this factual question will be resolved in applicant’s favor.

For these reasons, Applicants request an appeal conference be convened to advise Applicants whether the Office will 1) allow the present claims, 2) reopen prosecution and issue a new office action or 3) allow this case to proceed to appeal.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ozzie Farres', is written over a horizontal line.

Ozzie Farres
Registration No. 37,063

Hunton & Williams LLP
1900 K Street, NW
Washington, D.C. 20006-1109
Tel. (202) 955-1500
Fax (202) 778-2201

Date: October 20, 2006